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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/715,978 | 11/17/2000 | Alex Y. Chan | 062891. 0446 | 6685 |

7590

01/13/2004

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| EXAMINER |
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GROSS, KENNETH A

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| ART UNIT | PAPER NUMBER |
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2122

DATE MAILED: 01/13/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,978

Applicant(s)

CHAN ET AL.

Examiner

Kenneth A Gross

Art Unit

2122

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the amendment filed on November 10th, 2003.
2. Claims 1, 3-6, 9, 11-14, 17, 19-22, 25, and 27-30 remain rejected under 35 U.S.C. 102(b). Claims 2, 7, 8, 10, 15, 16, 18, 23, 24, 26, and 31-33 remain rejected under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-6, 9, 11-14, 17, 19-22, 25, and 27-30 are rejected under 35 U.S.C. 102(b) as being anticipated by “Developing a WFT Workflow System”, Template Software Inc., 1998.

In regard to Claim 1, the Template Software reference teaches: (a) a run-time container (Page 2-6, figure 2-2, item “Deployed WFT workflow system”) operable to execute a workflow (Page 2-6, figure 2-2, item “Executable applications ready to be fielded”), the workflow comprising a number of workflow steps. The template software reference teaches tasks, which can be seen a workflow steps (Pages 5-9 and 5-10). The server item in this figure executes the workflow, as further taught on Page 7-4; (c) a design-time container operable to edit the workflow (Page 2-6, figure 2-2, item “WFT Development Environment”); (d) a contract specifying an interaction between a workflow step and a programming entity, the interaction comprising a service that the

Art Unit: 2122

programming entity provides for the workflow step when the workflow step is executed, the workflow step and the contract operable to be used for the next workflow. The Template Software reference teaches a workflow step in the form of a workflow task that performs a certain operation. The programming entity is interpreted to be the code written to perform the activities required for the task, as taught in the last line of Page 5-11. The service provided to the workflow step by the programming entity is the functionality of the programming code, the activities it carries out. The contract is interpreted to be the relationship between the workflow task and the programming code, so that when a task is executed, the interaction ensures that the code is executed for the task.

Claims 9, 17, and 25 are method, software, and system Claims that contain limitations that have already been addressed in the system Claim 1 and are rejected for the same reasons as Claim 1, where it would be obvious to include software as part of the system of Claim 1, since this allows user interaction with the functionality of the system, and it would be obvious to perform a method, since this is a result of the functionality of the system of Claim 1.

For specific rejections of Claims 3-6, 11-14, 19-22, and 27-30, see the office action mailed on August 11th, 2003.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2122

4. Claims 2, 7, 8, 10, 15, 16, 18, 23, 24, 26, and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Developing a WFT Workflow System”, Template Software Inc., 1998 in view of Jolissaint et al. (U.S. Patent Number 5,455,903).

In regard to Claim 33, Claim 33 contains limitations that have already been addressed in the rejection of Claims 1, 7, and 8, and Claim 33 is rejected for the reasons specified in these claim rejections.

For specific rejections of Claims 2, 7, 8, 10, 15, 16, 18, 23, 24, 26, 31, and 32, see the office action mailed on August 11th, 2003.

Response to Arguments

5. Applicant's arguments filed November 10th, 2003 have been fully considered but they are not persuasive.

Specifically, the applicant argues that the Template Software reference fails to disclose a contract specifying an interaction between a workflow step and a programming entity, the interaction comprising a service that the programming entity provides for the workflow step when the workflow step is executed, the workflow step and the contract operable to be used for the next workflow. The rejection put forth in this action addresses this limitation by interpreting a workflow task in the WFT reference with the workflow step, programming code as a programming entity, where the code performs a certain action, or service for the task specified. The contract is interpreted to be the relationship between the workflow task and the programming code, so that when a task is executed, the interaction ensures that the code is executed for the task.

Art Unit: 2122

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth A Gross whose telephone number is (703) 305-0542. The examiner can normally be reached on Mon-Fri 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


TUAN DAM
SUPERVISORY PATENT EXAMINER